

REMARKS

I. Status of the Claims

Claims 24 - 54 are pending in the instant application and stand rejected on various grounds. Claims 28 - 31, 36, 45, and 51 - 54 have been cancelled.

II. Rejections Under 35 U.S. C. §102

The Office Action identified a rejection to claims 24 - 27, 29 - 31, 35, 37 - 44, 46 - 52 and 54 under 35 U.S. C. §102 as being anticipated by Smith et al (U.S. Patent No. 6,185,707). Claims 29 - 31 and 52, 54 have been cancelled, while claims 24, 35, and 37 have been amended to recite the GUI feature that the Examiner noted is not disclosed by Smith. Reconsideration of the rejection based on the noted amendments is respectfully requested.

III. Rejections Under 35 U.S. C. §103

The Office Action also noted rejections to claims 28, 32 - 34, 36 and 45 under 35 U.S. C. §103 as being unpatentable over Smith in view of Testa et al (U.S. Patent No. 6,205,407). According to the Examiner, while Smith fails to disclose the GUI display feature, Testa does, and combined with Smith, renders the GUI-featured claims obvious. As noted above, claims 24, 35, and 37 were amended to recite the GUI features of claims 28 and 36 (claims 28 and 36 have been cancelled accordingly).

The present invention is directed to design-for-test (DFT) methods for testing semiconductor devices. Specifically, one of the key features involves the ability to display graphical representations of scan chains for a user for a fast and efficient determination or diagnosis of the test results.

Smith describes a method of using DFT data to determine physical locations within a logic integrated circuit. In other words, Smith teaches a method of correlating test failures to physical defects in an effort to "bitmap" areas of logic within the chip.

Testa describes a way of generating conventional ATE patterns for testing integrated circuits. Testa has no relevance whatsoever to the field of design-for-test (DFT) automatic test equipment (ATE). Additionally, Testa has no relevance to failure diagnosis. In fact, Testa teaches pattern generation, the opposite of diagnosis. Further, Testa does not describe any form of graphical user interface (GUI), but rather a mere

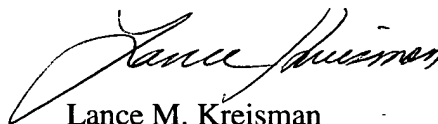
reference to the display of results from the testing of the device (col. 2, lines 34-35).

It is well-established that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

In contrast to the claimed GUI feature, Smith and Testa do not provide any motivation to combine their disclosures to render the claims obvious. Testa has no relevance to DFT applications, and Smith would not turn to non-DFT techniques to enhance his desire to locate physical defects. Reconsideration is respectfully requested for amended claims 24, 35, 37, and 38, and original claims 32 - 34. Because claims 25 - 27, 39 - 44, 46 - 50 depend directly and indirectly from claims 24, 35, and 38, these claims are believed allowable as well.

Please charge a one-month extension fee of \$110 to Deposit Account No. 20-0515.

Respectfully Submitted,



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